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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/784,319

02/20/2004

Martin Melchior

PO7978/LeA 36,317

2166

157 7590 06/11/2010  
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EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

06/11/2010

ELECTRONIC

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/784,319  
Filing Date: February 20, 2004  
Appellant(s): MELCHIORS ET AL.

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Robert S. Klemz  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 03/22/2010 appealing from the Office action mailed 08/25/2009.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any pending related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. However, it is noted that a prior Appeal, 2008-2963, was filed in this same application on 01/25/07, and decided by the Board on 09/24/08 with an affirmation.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 1, 3-5 and 12-14.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

### **WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner:

As limitations which do not find support in the original specification must be considered, the rejection of claims 1, 3-5 and 12-14 under 35 U.S.C. 102(b) as being anticipated by Kagerer et al. (WO 200177200) is withdrawn.

### **(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

### **(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-5 and 12-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is insufficient support for the new negative limitation wherein the polyurethane is explicitly "thiol group-free". There is no support in the original

specification for the limitation requiring the polyurethane in the process to be necessarily "thiol group-free".

**(10) Response to Argument**

Regarding the arguments against the "New Matter" rejections, the reference to "In re Marzoechi" is not apposite, as it does not respond to the issue of the new negative limitation, as has been added in the present claims.

Appellant has asked the examiner to provide evidence of the absence of the negative limitation in the specification. Of course, the evidence is the absence of the limitation in the original written description. As stated in the rejection, there is no description in the original specification of a limitation requiring the polyurethane in the process to be "thiol group-free". The list of possible new negative limitations is limitless (no silicone moiety, no silver moiety, etc), yet they would all represent new intermediate inventions, not contemplated/described by appellant in their original specification.

None of the sections of the original specification pointed to by appellant (i.e., page 7, line 31 through page 10, line 11 and page 11, line 22 through page 13, line 11) provide said support for the new matter limitations. The lists of examples of compounds included in (A2) to (A5), as reactants with the isocyanates, do not include any exclusion of such compounds that may contain a "thiol group", nor do they exclude other reactant compounds, in addition to the compounds listed, that may contain a "thiol group". The mere absence of the mention of a species in a disclosure teaching the genus, is not, in and of itself, sufficient support for a new negative limitation excluding said species.

In this case, the claim term "polyurethane" encompasses polyurethanes including thiol functionalities, as may be presented by some compounds reacted with the isocyanate to form the polyurethane. Therefore, it is the perspective of the examiner that by adding the recitation "thiol group-free", the appellant has amended the claims to define a new intermediate class of polyurethane which is narrower than the class of polyurethane embraced by the unqualified term "polyurethane", broader than the group of polyurethane reactants explicitly exemplified in the specification pages, but not disclosed in the specification as originally filed.

There is simply nothing in the original disclosure of this application which would have conveyed to an artisan that the appellants had possession on the application filing date of such a process involving such an intermediate class of polyurethane. In re Kaslow, *supra*.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Dr. Kelechi C. Egwim/

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